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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1966

No. 743

NORTON COMPANY, STUDEBAKER-PACKARD CORPORATION, and HADCO CORPORATION, *Petitioners*

v.

MINNESOTA MINING AND MANUFACTURING COMPANY, *Respondent*

**On Petition for Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit**

## BRIEF FOR PETITIONERS IN REPLY TO RESPONDENT'S BRIEF

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Respondent's Brief (page 3) distorts Petitioners' questions, by arguing that they are based on an "assumption" that the patent is invalid, and then complains that this is the very issue in controversy. Petitioners' questions are not based on an "assumption". They start with the unchallenged premise that this patent was invalid *at the time it issued,* because of 35 U.S.C. 185 as applied by the Court of Appeals in *Beckman Instruments, Inc.* v. *Coleman Instruments, Inc.,* 338 F. 2d 573, 7 Cir., 1964. The Court of Appeals below stated this interpretation of the Beckman case (Appendix to Petition, page 8A, second paragraph).

Respondent's Brief does not explain how such a patent, invalid *upon issuance,* can be made valid years

later and by *ex parte* action at the Patent Office, even while the patent is involved in litigation in a District Court. Respondent does not attempt to explain how the rights of the public to defend against such a patent, invalid when it issued, can be taken away from the public.

Respondent nowhere even attempts to explain away the plain language of Section 185 that, "Notwithstanding any other provisions of law . . ." the party ". . . *shall not receive* . . ." a patent if he has not previously procured the license required by Section 185.[1]

Respondent does not discuss the *public interest* in the avoidance of scarecrow patents. Respondent has no rebuttal to Petitioners' point that invalid patents are going to pose as valid ones if the Court of Appeals decision becomes the law.

Petitioners further note that an erroneous impression is raised by the Respondent's "Statement Of Facts" which state that the "foreign filings were inadvertently made . . . by a stenographer's error . . . and a lawyer's failure to catch that error" (Respondent's Brief, page 5).

The proceedings in the District Court never reached the stage of *inter-parties* investigation of the *facts* behind the foreign filings, nor were any judicial findings made of such facts. Instead, the case was decided by the District Court solely on the *point of law involved,* and reviewed by the Court of Appeals on that basis.

Respondent's approach upon the Commissioner of Patents to obtain the retroactive license was made while the case was before the District Court and was entirely *ex parte.*

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[1] Emphasis supplied.

Therefore, it is inappropriate for Respondent to include in its brief to this Court, an argument suggesting there was a finding that an "invertency" had occurred.[1, 2]

In summary, the issue to be decided in this case remains one solely of statutory construction, and the Petition should be granted so that the important Federal questions involved may be settled by this Court.

Respectfully submitted,

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[1] If it be appropriate to refer to these facts, then in regard to the foreign filings, it is just likely they were done without awaiting a license deliberately, as to meet a critical date, witness the urgent dictate to file "—immediately or before January 25, 1959" in the letters of instruction dated January 13th to foreign agents (Petitioners' Appendix, pages 33b-37b, inclusive). Note also on each letter (lower left corner) the instruction to send a "Full Rate Cable" on the "Same Day" the letter was received, and another on the day the application was filed.

[2] It is also error for Respondent to state at page 2 of its Brief that the Court of Appeals noted the invention to be "revolutionary", when that Court only noted that the Respondent *alleged* it to be so, see Appendix to Petition, page 4A, 1st paragraph.